REMARKS

Claims 40-42, 50-56, and 61-64 are currently pending. The Examiner presents several rejections that are rebutted in the following order:

I. Claims 40-42 and 50-56 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over US Patent No. 6,067,467 To John.

II. Claims 40-42 and 50-56 are rejected on the grounds of nonstatutory obviousness type double patenting as allegedly being unpatentable ofver claims 1-8, 10-18, and 22-29 of US Patent No. 6,622,036.

I. The Claims Are Not Obvious In View Of John

Obviousness is determined based upon an evaluation of the magnitude of the differences between the claimed embodiment and the asserted prior art:

> In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966), the Court set out a framework for applying the statutory language of § 103 "Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained

KSR v. Teleflex, 127 S. Ct. 1727, 1734 (2007). Further, the *KSR* holding only cautioned against a strict application of the "teaching-suggestion-motivation test" such that an explicit teaching is not required to be found within the cited applications. Nonetheless, *KSR* has not changed the law regarding the requirement to establish a prima facie case of obviousness by: i) finding some motivation to combine the references either explicitly or implicitly, ii) finding a teaching or suggestion of all the claim limitations in the cited references; and iii) demonstrating that the references provide sufficient technical detail such that one having ordinary skill in the art would be provided with a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991); and *MPEP § 2142*; Establishing A Prima Facie Case Of Obviousness. The Applicants

rely upon the argument made in the previous response (herein incorporated by reference) and further submit the argument below demonstrating that the Examiner has not made a prima facie case of obviousness.

The Examiner states that:

> ... it would be obvious to a skilled practictioner in the art to take additional EEGs of an awaken patient because the reference discloses that multiple EEGs are taken of the patient. ... Hence, a second EEG when a patient is 'awake' is within the scope of John. ... any EEGs taken during recovery/ICU after the anesthesia wears off results in the patient being awadken from an inactive state..

Office Action pg 4. The Applicants disagree. The Examiner has apparently overlooked that the Applicants' claim is directed to "determining drug efficacy". The EEG monitoring taken by John in the Recovery/ICU, as admitted by the Examiner, is to establish a new 'self-norm', wherein there is no drug present:

> The recovery room/ICU monitoring enables the doctor to obtain a new self norm for the patient at each stage of recovery ...

Office Action pg 4. Here, John is no longer determining whether or not the level of administered anesthesia should be adjusted in order to maintain a steady anesthetic plane. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 40 & 54 to recite that the patient comprises 'a physiologic brain imbalance" that is 'identified using a first electroencephalography recording':

> ... neurophysiologic information can be used as an independent variable to identify physiologic brain imbalances

Applicants' Specification pg 3 ln 9-10, and

> ... EEG recordings are used to track changes produced by the administration of medications.

Applicants' Specification pg 33 ln 8-9. These amendments are made not to acquiesce to the Examiner's argument but only to further the Applicant's business interests, better define one embodiment and expedite the prosecution of this application.

John does not teach a patient comprising a physiologic brain disorder identified with an electroencephalography recording. In fact, John **expressly disclaims** using an electroencephalography recording to identify a physiologic brain disorder:

> The present use of discriminant functions is not to classify a group into a class or an individual with respect to specific disorders (psychiatric diagnosis); but rather to characterize the brain state of a patient at a particular time (intraoperatively).

John col 11 ln 5-9 [emphasis added]. Clearly, John strongly teaches away from the Applicants' presently claimed embodiment, thereby rebutting the Examiner's present rejection.

The Applicants respectfully request that the Examiner withdraw the present rejection.

II. There Is No Double Patenting

The Examiner states that:

> Claims 40-42 and 50-56 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8, 10-18, and 22-29 of U.S. Patent No. 6,622,036. ... they are not patentably distinct from each other because both sets of claims involve determiing the medication efficacy.

Office Action pg 7. The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants now provide a Terminal Disclaimer to United States Patent No. 6,622,036. This Disclaimer is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application[1].

[1] Further, the Applicants question the USPTO's continued obviousness-type Double Patenting rejection practice, now that all continuing applications expire based upon the filing date of the parent application.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 781.828.9870.

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